

Docket No. 420-002

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	
	:	
CHRISTOPHER S. NOLAN	:	
	:	
Serial No. 09/684,032	:	Group Art Unit: 3652
	:	
Filed: October 6, 2000	:	Examiner: Charles A. Fox
	:	
For: LINER FOR CONTAINER	:	
WITH SIDE DOOR	:	

REPLY BRIEF

Dear Sir:

This Reply Brief follows the Examiner's Answer mailed October 25, 2006. This reply is necessary to address the Examiner's remarks in response to Appellant's Appeal Brief.

With regard to the rejections under 35 U.S.C. §102(b) in view of U.S. Patent No. 3,951,284 to Fell et al. (the "'284 Patent"), the Examiner again admits that this patent does not disclose a liner with an access opening along at least one of the side panels, as required by Appellant's claim 1, 2, 5, and 6. *See Examiner's Answer p. 4* ("...***Fell et al. [the '284 Patent] do not explicitly teach the opening in the side of the liner...***"). Since the Examiner admits that each and every claim limitation is not met by the '284 Patent, the rejections under 35 U.S.C. §102(b) must be reversed.

As for the rejections of claims 1, 2, 5, 6, 13, and 17, as being obvious in view of the '284 Patent, the Examiner now argues that the '284 Patent discloses "placing the opening in the liner adjacent to the door opening of the container." *Examiner's Answer p. 7*. The '284 Patent states that "...there is provided a device for transporting bulk material in a shipping

vehicle *having walls, one of which defines a door opening* and doors attached thereto. . .” ‘284 Patent, Col. 2, ll. 9-12 (emphasis added); *see also* Col. 2, ll. 25-28. Instead of suggesting that “the door to the container can be in any of the walls to the container,” this passage merely states that one of the walls defines a *door opening*. *To stretch this passage as proposed would require the entire elongated side wall of the container to “define” a door opening*. This construction of the ‘284 Patent’s true teaching is supported by every figure presented in the patent. Specifically, each figure shows an *entire* wall (in this case, the rear wall) “defining” the door opening. When properly reviewing the ‘284 Patent *as a whole*, it is clear that this patent only contemplated a liner with *an access opening for loading or unloading in an end of the liner*, and not as set forth in Appellant’s claims.

In addition to statements taken out of context, the Examiner’s arguments rely on assumptions unsupported by substantial evidence in the record. Specifically, the Examiner notes that the ‘284 Patent mentions use of the liner in “rail freight cars,” From this, he takes “official notice” that “rail freight cars do not have door openings in their ends and usually have openings along their mid point....” From this unsupported assertion it is deduced that the ‘284 Patent teaches a liner with an access opening along at least one side panel.

Although it is convenient to make unsubstantiated conclusions to supplement a reference’s teachings, this is entirely improper. *See In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) (stating that “the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). As there are many configurations of rail freight cars (e.g., lorry style, coil cars, auto carriers, flatcars, gondolas, hopper cars, covered hoppers, tank cars, slate wagons, stock cars, well cars, transporter wagons, etc.), the mere incantation of a “rail freight car” does not mean it must have a door opening along its side or a liner having an access opening along at least one side panel. Since the ‘284 Patent fails to teach or suggest the Appellant’s liner (as evidenced by the Examiner’s need to develop unsupported “facts” to

supplement this patent's teachings), and the Examiner's "official notice" is wholly improper, the rejection to claims 1, 2, 5, 6, 13, and 17 must be reversed.

With regard to claims 3 and 4, the Examiner admits that the '284 Patent fails to "teach the liner and tubes as being a plastic sheet material joined by heat welding of the mating surfaces." However, U.S. Patent No. 5,028,197 to Krein et al. (the "'197 Patent") also fails to supply this teaching, and the record otherwise lacks any objective evidence of it. The '197 Patent *never* makes direct reference or allusion to a liner with "an access opening along at least one side panel," nor a liner and "open tube" formed of plastic sheet and a heat seal bead. Therefore, claims 3 and 4 must be allowed.

Claim 12 requires "[t]he liner of claim 1 *in combination with a source of air for erecting the liner.*" The background of the '284 Patent clearly discusses the need for a liner that *does not use air* for erecting the liner. See '284 Patent, Col. 1, ll. 40-47. Instead, the focus of the '284 Patent is an elaborate mechanical connection system for holding the liner in place. Since the '284 Patent teaches away from using air for erecting the liner (and incorporates the connection system to avoid using air), the combination of the '284 and '197 Patents is improper. See *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983) (finding that it is improper to combine references where the references teach away from their combination). Moreover, the Federal Circuit has held that "[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis added). In this instance, the '284 Patent discusses the desirability of a liner that is installed without use of air. Accordingly, the cited combination of patents is improper and fails to establish a *prima facie* case of obviousness.

Although the Examiner states that his failure to mention claim 16 in the final Office Action was a "typographical error," in his Answer, he *again* fails to substantively address this claim. Claim 16 requires "a manifold including a plurality of orifices for enabling installation of the liner via air pressure." To date, the Examiner has failed to identify where

either of the '284 or '197 Patents teach this limitation. Since neither of these patents teach or suggest the "manifold" of claim 16, and the Examiner has failed to provide substantial evidence of such, the rejection to this claim must be reversed.

Similarly, with regard to claims 7 and 8, the Examiner again fails to provide substantial evidence to support the proposition that these claims are obvious in view of the '284 Patent and U.S. Patent No. 5,746,862 to Derby (the "'862 Patent"). In fact, on page 10 of the Examiner's Answer, he again acknowledges that the '862 Patent *fails to teach the placement of Appellant's folds*. Claim 7 clearly requires that "the *side panels* include folds to allow expansion." Nowhere does the '862 Patent show side panels including folds to allow expansion. Even if one were to construe the gussets 22 and 24 as the folds in claim 7, *they are not in the side panels, as explicitly acknowledged by the Examiner!* Claim 8 further requires that the end panels are formed by "folded end sections" of the side panels and a heat seal bead extending across the folds. In his Answer, the Examiner provides absolutely no indication where the '862 Patent teaches such a configuration. Accordingly, claims 7 and 8 must be allowed.

Although the Examiner found Appellant's arguments regarding claims 14 and 18 "confusing" because of an inadvertent transposition, the Examiner nevertheless understands and acknowledges that U.S. Patent No. 4,516,906 to Krein (the "'906 Patent") *does not require* an elaborate connection system, while the '284 Patent *expressly requires* an elaborate connection system. *In fact, he agrees that the '906 Patent disparages the '284 Patent. Examiner's Answer p. 11.* Despite this clear understanding of the teachings of these patents, the Examiner chooses to defy well-settled precedent of the Federal Circuit, which holds that it is improper to combine references where the references teach away from their combination. *In re Grasselli, supra*. Since these references clearly teach away from their combination (as admitted by the Examiner), the rejection is improper and must be reversed.

Furthermore, as opposed to providing arguments in support of his position or otherwise addressing the deficiencies of the rejection to claims 14 and 18, the Examiner in

the Answer begins importing limitations from Appellant's specification into the claims. Besides being wholly improper to the analysis of the claims for patentability, it is also illogical. The mere fact that the '906 Patent may or may not include a structure similar to one discussed in Appellant's specification does not address whether the combination of the '284 and '906 Patents is proper, nor whether Appellant's claims are patentable. Instead, the Examiner's reference to Appellant's specification is a smokescreen in an attempt to avoid the true issue, that is, that the combination of the '284 and '906 Patents is improper and fails to teach or suggest a free-standing liner with a side panel opening.

Turning to claim 15, as acknowledged by the Examiner, U.S. Patent No. 3,456,834 to Paton (the "'834 Patent") fails to teach or suggest Appellant's configuration of liner having four elongated panels to substantially match the sides, top, and bottom of a container, as well as first and second end panels to complete the liner. Combining the teachings of this patent with the teachings of the '284 Patent, as proposed by the Examiner, would completely change the principle of operation of the apparatus disclosed in the '834 Patent. In particular, the '834 Patent discloses a container 100 having openings 108 positioned at the ends of the container 100 for applying suction to draw a membrane section 3h toward the openings during installation. As previously discussed, the '284 Patent only contemplates having an opening in the *end* of the liner, *not in the side panel* of the liner. Utilizing the liner having openings in the end, as taught in the '284 Patent, would prevent installation of the membrane section 3h. As suction is applied to the openings 108 the air would be drawn out of an interior of a liner having openings in the end (the only configuration taught in the '284 patent), as opposed to drawing a portion of the liner toward the ends of the container 100. Since the proposed combination would dramatically change the operation of the "prior art invention" by prohibiting installation of the membrane section 3h, a *prima facie* case of obviousness is lacking and the Examiner's rejection of claim 15 must be reversed. See Section 2143.01 of the Manual of Patent Examining Procedure ("[i]f the proposed. . . combination of the prior art would change the principle of operation of the prior art invention

being modified, *then the teachings of the references are not sufficient to render the claims prima facie obvious.*" (emphasis added)).

In summary, Appellant has addressed and overcome every rejection made by the Examiner. Upon careful review of the cited references in light of the comments made in the Appeal Brief and this Reply Brief, it is believed that the Board will agree that all of the presently pending claims should be allowed. Accordingly, it is respectfully requested that the rejections of the Examiner be reversed and that the present application be remanded for allowance. Although Appellant believes that no fees are due, the undersigned authorizes the deduction of any necessary fee from Deposit Acct. No. 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the firm name 'KING & SCHICKLI, PLLC'.

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